

REMARKS

This Application has been carefully reviewed in light of the Office Action mailed April 18, 2005. At the time of the Office Action, Claims 1-20 were pending in this Application. Claims 1-20 were rejected. Claims 1, 3, 8, 9, 15 and 18 have been amended to further define various features of Applicant's invention. Claims 7 and 13 have been cancelled without prejudice or disclaimer. Applicant respectfully requests reconsideration and favorable action in this case.

Rejections under 35 U.S.C. § 102

Claims 1-3 and 5-7 were rejected by the Examiner under 35 U.S.C. §102(b) as being anticipated by UK Patent Application No. GB2246115A by Stephen Gale ("Gale"). Applicant respectfully traverses and submits the cited art does not teach all of the elements of the claimed embodiment of the invention.

Claims 1-3 and 5-7 were rejected by the Examiner under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 6,488,153 issued to John Jay Morris ("Morris"). Applicant respectfully traverses and submits the cited art does not teach all of the elements of the claimed embodiment of the invention.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1997). Furthermore, "the identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co. Ltd.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Applicant respectfully submits that the cited art as anticipatory by the Examiner cannot anticipate the rejected Claims, because the cited art does not show all the elements of the present Claims.

Among other elements, independent Claim 1, as amended, recites a breakaway packing system that utilizes a detachable joint "operably detachable to cause the top section to separate from the bottom section ..." and "designed to maintain the packing support intact while being packed and to allow the top section to be detached from the bottom section,

thereby allowing removal of the information handling system and maintaining the bottom section within the shipping container.”

The Gale reference describes packing fitments 14. See Figure 1. Packing fitments 14 include a first portion that includes an upper horizontal bar 16 that is connected with a side bar 20 and a second portion made up of a lower horizontal bar 18 connected with another side bar 20. Because of the L-shaped form of this first portion and second portion, removal of first portion without requiring removal of the second portion, prior to detachment of the joint, is not shown or suggested. Accordingly, the packaging materials taught by Gale fail to disclose, teach or suggest a detachable joint that allows a top section of a packing support to be removed such that an information handling system can be removed from a box while the bottom section of the packaging support remains in the box. Instead, the entire packing fitment would need to be removed from a container before the separate portions could be detached from one another.

The Morris reference relates to cushioning members for transporting articles. Column 1, lines 5-7. Specifically, Morris discloses cushioning members 12 to define an internal corner for contacting the external surfaces of an article. See Column 4, lines 43-46. However, Morris fails to disclose, teach or suggest a packing support with a top section and a bottom section that can be detached as recited in independent Claim 1.

For at least these reasons, Applicant respectfully submits that Gale and Morris each fail to disclose, teach or suggest each and every element as set forth in independent Claim 1. Accordingly, Applicant requests reconsideration, withdrawal of the §102 rejections and full allowance of independent Claim 1 and Claims 2-3 and 5-6 which depend therefrom.

Rejections under 35 U.S.C. §103

Claim 4

Claim 4 was rejected under 35 U.S.C. §102(b) as anticipated by or, in the alternative, under §103(a) as being obvious over either Gale or Morris. Applicant respectfully traverses and submits the cited art combinations, even if proper, which Applicant does not concede, does not render the claimed embodiment of the invention obvious.

Applicant submits that Claim 4 depends from independent Claim 1 which has now been placed in condition for allowance. For the reasons discussed above, Applicant submits that Claim 4 is neither anticipated nor rendered obvious by Gale or Morris considered either alone or in combination. Applicant requests reconsideration, withdrawal of the rejection under either §102(b) or §103(a) and full allowance of Claim 4.

Claims 8-10 and 12-18.

Claims 8-10 and 12-18 were rejected under 35 U.S.C. §103(a) as being unpatentable over Prior Art Figure 1 ("PA1") of the instant application in view of U.S. Patent No. 4,287,990 issued to James F. Kurick ("Kurick"). Applicant respectfully traverses and submits the cited art combinations, even if proper, which Applicant does not concede, does not render the claimed embodiment of the invention obvious.

In order to establish a *prima facie* case of obviousness, the references cited by the Examiner must disclose all claimed limitations. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

Independent Claim 8 recites an information handling system package for shipment that includes "operably designed to maintain the packing support intact while being packed to allow the first section to be detached from the second section, thereby allowing removal of the information handling system and maintaining the bottom section within the shipping container." Similarly, independent Claim 15 recites a method of packing an information handling system that includes the steps of, "placing a portion of a chassis of an information handling system into a packing support such that at least one edge of the chassis is secured within the packing support" and "detaching a top section of the packaging support from a bottom section of the packaging support by separating at least one detachable joint to allow removal of the information handling system from the shipping container and maintain the bottom section within the container."

As indicated by Examiner, PA1 discloses a two piece packing foam unit that does not include a detachable joint. Examiner cites to Kurick to combine with PA1. Kurick is directed to package material for shipping and storing sheet materials, in particular, a stack of individual automotive windshields or other curved glass articles. See Column 1, lines 6-10.

Kurick discloses a simple connector portion 36 in the form of pins 37 formed to be inserted into sockets 38. See Column 3, lines 30-33. Alternately, Kurick discloses the use of tongue and groove interface between the two pieces of packing foam. See Column 3, lines 33-37.

Applicants submit that the pin and socket or tongue and groove connections recited by Kurick fail to maintain the packaging of PA1 (the propriety of such combination, Applicants do not concede) to maintain the packaging intact while being packed and then to allow the first section to detach from the second section as recited in independent Claim 8. Similarly, the pin and socket or tongue and groove connections also fail to secure the packing support with respect to a portion of a chassis and also allow the detachment of a top section of the packaging support from a bottom section, allowing removal of the information handling system from the shipping container while maintaining the bottom section within the container, as recited in Independent Claim 15.

Accordingly, Applicant respectfully submits that the combination of PA1 and Kurick fails to disclose, teach or suggest each and every limitation of Independent Claims 8 and 15. Applicant requests reconsideration, withdrawal of the §103 rejections and full allowance of independent Claims 8 and 15 and Claims 9-10 and 14-18 which depend therefrom.

Claims 11, 19 and 20

Claims 11 and 19 were rejected under 35 U.S.C. §103(a) as being unpatentable over PA1 and Kurick as applied to Claims 8 and 15, and in further view of U.S. Patent No. 3,511,990 issued to Robert M. Hauss ("Hauss"). Claim 20 was rejected under 35 U.S.C. §103(a) as being unpatentable over PA1 and Kurick as applied to Claim 15, and further in view of Morris.

Applicants submit that Claims 11, 19 and 20 depend from claims that have now been placed in condition for allowance thereby obviating the present §103 rejections. Applicants respectfully request reconsideration, withdrawal of the §103(a) rejections and full allowance of Claims 11, 19 and 20.

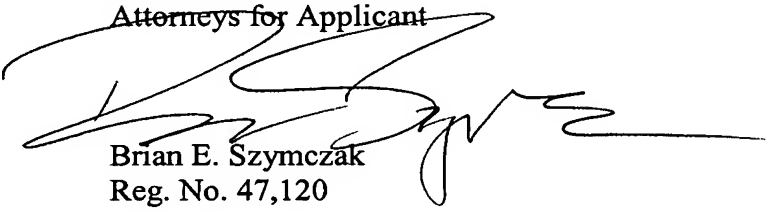
CONCLUSION

Applicant has now made an earnest effort to place this case in condition for allowance in light of the amendments and remarks set forth above. Applicant respectfully requests reconsideration of Claims 1-20 as amended.

Applicant believes there are no fees due at this time, however, the Commissioner is hereby authorized to charge any fees necessary or credit any overpayment to Deposit Account No. 02-0383 of Baker Botts L.L.P.

If there are any matters concerning this Application that may be cleared up in a telephone conversation, please contact Applicant's attorney at 512.322.2548.

Respectfully submitted,
BAKER BOTTS L.L.P.
Attorneys for Applicant


Brian E. Szymczak
Reg. No. 47,120

SEND CORRESPONDENCE TO:

BAKER BOTTS L.L.P.

CUSTOMER ACCOUNT NO. **23640**

512.322.2548

512.322.8383 (fax)

Date: 7/14/05